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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,465	01/04/2001	William J. Gray	10655.9900	3628
7590	12/05/2005		EXAMINER	
Howard I. Sobelman Snell & Wilmer L.L.P. One Arizona Center 400 E. Van Buren Phoenix, AZ 85004-2202			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	
			DATE MAILED: 12/05/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,465	GRAY ET AL.	
	Examiner	Art Unit	
	Calvin L. Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,39 and 40 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Status of Claims

1. Claims 1, 3-5, 39 and 40 have been examined.

Response to Amendments

2. The Examiner has applied new 112 rejections to Applicant's amended claims. Specifically, it appears that Applicant's claims are replete with new and indefinite subject matter, therefore, the Examiner is interpreting the claims as follows:

- (claims 1 and 40) receiving a request at a wallet server, from a user, for payment authorization, said payment authorization directed to a financial institution
- (claims 1 and 40) receiving authorization of said request by said wallet server, from a security server
- (claims 1 and 40) associating authentication data, by said wallet server with a form
- (claims 1 and 40) providing said form to a merchant server to facilitate the use of said form to obtain authorization from said security server

- (claim 3) method of claim 1 wherein said request is a secure checkout procedure
- (claim 4) method of claim 1 wherein said wallet server is a web, database or application server
- (claim 5) claim 1 further comprising inserting smart card data onto a client or computer system
- (claim 39) an interface configured to receive an authorization request from a user
- (claim 39) a module configured to provide a form to a merchant server to facilitate the use of said form to obtain authorization from a security server

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-5, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 39 and 40 recite “prompting a user to insert at least one of a debit card, a credit card, a charge card, and a smart card into a card reader”. The Specification as originally filed recites using a smart card for debit and credit transactions (Specification, page 4, lines 3-5) and does not disclose a card reader or inserting a card into a card reader (Specification, page 10, lines 22-24). Similarly, Applicant’s Specification does not disclose “receiving signature data...” or performing any other processing using “signature data” as the Specification is silent regarding “signature data”. Claims 1, 39 and 40 also recite “signature data” used to determine whether a card is physically interfaced with a card reader. However, this limitation and other limitations regarding determination or authentication associated with physical interfacing and “signature data” is also not present in the Specification as originally filed. And, although Applicant does describes verifying that a smart card is in a user’s possession by inserting a smart card into the system (Specification, page 10, lines 22-25) Applicant is silent as to how the card is inserted into the system (e.g. contactless, docking station, keyboard for manually entering a card number).

Claims 3-5 are also rejected as they depend from claim 1.

Claim 2 recites a request including purchase, charge and at least one of debit, credit, charge or smart card identifying information. However, Applicant’s

Specification is silent regarding these additional “request” features (Specification, pages 11, lines 10-16).

Claim 4 has been amended to read on a wallet server as a digital server. However, the Specification as originally filed teaches a wallet server as a server in the context of client/server architecture (Specification, page 10, lines 7-11) and not as a digital wallet.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 3-5, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 39 and 40 recite “receiving signature data”, for example, read by a card reader. Applicant’s Specification on the other hand discloses a smart card that includes a digital certificate (Specification, page 10, lines 27-29).

Claims 3-5 are also rejected as they depend from claim 1.

Claims 1, 39 and 40 recite “signature data configured to authenticate that...”, however, to one of ordinary skill structure is configurable not data.

Claims 3-5 are also rejected as they depend from claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan, U.S. Patent No. 6,327, 578.

As per claims 1-4, 39 and 40, Linehan teaches a method for facilitating a transaction comprising:

- receiving a request at a wallet server, from a user, for payment authorization, said payment authorization directed to a financial institution (column/line 5/61-6/4) where said wallet server is a web, database or application server (figure 7)
- receiving authorization of said request by said wallet server, from a security server (figures 2B and 8; column 6, lines 1-35; column/line 8/53-92)
- associating authentication data, by said wallet server with a form (column 6, lines 36-43)

- providing said form to a merchant server to facilitate merchant using said form to obtain authorization from a security server (column 6, lines 36-43 and 47-62)
- receiving the request as part of a secure checkout procedure (figure 2B; column/line 5/50-6/3)
- an interface configured to receive an authorization request from a user (figure 2B)
- a module configured to provide a form to a merchant server to facilitate the use of said form to obtain authorization from a security server (column 6, lines 36-43 and 47-62)

Regarding a coincidence between the security server from which the wallet server receives authentication data and the security server that receives a "form" from a merchant. Linehan teaches a security server such as a bank (figure 2A, items 208 and 212), therefore, if in the Linehan model, the merchant and the user share the same bank or financial institution, this limitation is satisfied.

Regarding "forms", in order to settle a dispute a merchant can produce a copy of the token that contains data such as payment amount, order description, time stamp, a random nonce, merchant ID, and customer account reference number. Further, the token is completed, and transmitted to a merchant by the wallet server and the merchant server, in turn, transmits the token to a security server (column 6, lines 20-37). Hence, the token of Linehan satisfies the

conditions of a "form" according to Applicant's Disclosure (Specification, page 10, lines 17-28).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan, U.S. Patent No. 6,327, 578 in view of Chen et al., U.S. Patent 5,590,197.

As per claim 5, Linehan discloses a method for authenticating a transaction using a digital wallet, wallet server and a smart card such as computer or electronic device with a circuit board with built in logic or firmware that gives the computer, electronic device, or circuit some kind of decision making ability (column 5, lines 50-58). However, Linehan does not specifically recite inserting the smart card data into or onto a user computer. Chen et al. teach storing a wallet on a smart card, and loading (i.e. inserting) the wallet onto a user computer (abstract; column/line 4/43-5/60; column 6, lines 28-47). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Linehan and Chen et al. in order to allow the user to have access to multiple cards ('197, column 6, lines 28-31) and use the wallet for internet or offline transactions '197, column 5, lines 42-62; column 6, lines 23-27).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

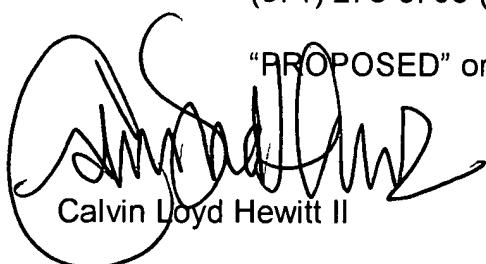
Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")



Calvin Loyd Hewitt II

November 28, 2005